Remarks/Arguments

Applicants respectfully request reconsideration and allowance in view of the foregoing amendments and following remarks. In the Office Action, mailed February 10, 2006, the examiner rejected claims 21-40. By this amendment, claims 21 – 40 remain in this response and independent claims 21 and 31 are amended for overcoming the rejections of the patentability. No new matter is entered.

Concerning the patentability of the amended independent claim 21 with respect to Lee (US 2003/0234795) in view of Champion et al (US 6,774,953), the amended claim 21 comprises an **adder circuit for summing the first converted color element, the second converted color element and a target color element** to thereby generate a color element of the output color, wherein **both of the input color and the output color are in a RGB format** including R, G, and B components respectively representing red, green, and blue colors, and **both of the target color element and the color element of the output color relate to the same component, that is R, G, or B component**. As a result, Lee not only fails to disclose both of the input color and the output color are in the RGB format but also fails to teach or suggest the target color element and the color element of the output color relate to the same component, which is R, G, or B component. Although Champion et al disclose the input color and the output color are both in RGB format, but they fail to teach or suggest an adder for summing three color elements which comprise the first converted color element, the second converted color element and the target color element, and also fail to disclose both of the first and second converted color element are outputted by look-up tables. Since Champion et al fail to teach or suggest an adder circuit for summing three color elements and two of them outputted by look-up tables, Lee in view of Champion provides no teaching or suggestion about how to combine these two prior arts to realize the claimed invention.

Furthermore, it is well-settled law that in order to properly support an obviousness

rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

> "The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Hence, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a color conversion apparatus, as claimed by the Applicants.

Moreover, evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be

combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

For at least the above-mentioned reasons and considerations, the claimed invention is in condition of allowance over Lee in view of Champion et al. A similar argument applies to currently amended independent claim 31, and the dependent claims should be allowable for at least the same reasons. Consideration of pending claims 21-40 is respectfully requested.

Sincerely yours,

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